

Appl. No.: 09/800,083
Amdt. Dated: September 16, 2005
Off. Act. Dated: May 16, 2005

REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested in view of the foregoing amendments and discussion presented herein.

1. Rejection of Claim 4-5 and 12-13 under 35 U.S.C. §112.

Claim 4-5 and 12-13. The rejection of Claim 4-5 and 12-13 contends that the use of "*the internet service provider (ISP)*" is indefinite.

It should be appreciated that inherent aspects needs not be introduced with the indefinite article, such as "a" or "an". Examples in the MPEP include that of "the circumference of a circle" and so forth. In the instance with regard to these claims an internet service provider is an inherent aspect of sending mail over the internet.

However, as it does not particularly detract from the claim or add too much confusion, the Applicant has revised these claims to recite "*an internet service provider*".

2. Rejection of Claims 1-3, 6-11 and 16-20 under 35 U.S.C. §102(b).

Claims 1-3, 6-11 and 16-20 have been rejected under 35 U.S.C. §102(b) based on the patent of Reber et al. (U.S. Pat. No. 6,032,195).

After carefully considering the grounds for rejection the Applicant responds as follows.

Claim 1. This is an independent claim drawn to a system for sending temporally displaced electronic message over a network.

In support of the rejection a number of aspects of the Reber system are improperly equated to elements of Claim 1. In particular Examiner states that Reber teaches encoding a "*temporal specifier (optical code)*" into an electronic mail message. Examiner refers to figure 1 and column 2, lines 5-64 of Reber. It is difficult for Applicant to determine what specific teaching the Examiner is relying upon in this large section of

text, almost an entire column. Upon examining this text, Applicant find nothing in support of Examiners contention. What Applicant does find is support that the specifier of Reber is an address read by the optical reader, see col. 2, lines 19-24, and lines 58-60. In the latter, the statement in Reber is made: *"The optical code 14 either directly or indirectly encodes navigation data for navigating to the destination 20 via the electronic network 10. For example, the optical code 14 can encode, in accordance with a bar code format, the electronic address for the destination 10."*

As can be seen, Reber does not teach the encoding of a temporal specifier, or the delivery of the email in response to that temporal specifier. Instead, Reber teaches converting a printed code (element 14 in FIG. 1) which is read by an optical interface (element 32 in FIG. 1). The system of Reber decodes a network address from the optical reader for addressing the electronic message (a spatial parameter and not a temporal one).

However, the temporal specifier of the Applicant directs the system to a time at which the email is to be resent from the system on to the destination. The word "temporal" from the Webster's Unabridged dictionary of the English language is given as (1) "of or pertaining to time".

Applicant's Claim 1 describes the encoding of a temporal specifier within the email message at the sending system, and the decoding of this temporal specifier wherein it is used to determined when the email is sent to its destination address as set by the sender. None of these aspects are addressed by the relied upon reference.

Accordingly, as not all claim references are met by the Reber reference, the reference does not anticipate Claim 1.

Therefore, Applicant respectfully requests that the rejection of Claim 1, and the claims which depend therefrom, be withdrawn.

Claim 11. Independent Claim 11 is rejected without being separately considered, although it provides significantly greater detail on the elements of the

Appl. No.: 09/800,083
Amdt. Dated: September 16, 2005
Off. Act. Dated: May 16, 2005

invention. This is contrary to examining guidelines espoused by the MPEP.

In responding to the Office Action, Applicant noted and corrected that Claim 11 was missing a portion of the preamble - this has been remedied by copying that portion from Claim 1.

Claim 11 is somewhat more specific than that of Claim 1, and it recites "*retaining the electronic message until the specified time coordinate arrives; and sending the electronic message to the destination address*". These aspects are more clearly addressed, and again not taught by the Reber reference.

Therefore, there is no support for an anticipation rejection of Claim 11 and Applicant respectfully requests that the rejection of Claim 11 and the claims which depend therefrom be withdrawn.

Claim 17. The third independent Claim in this group of claims is Claim 17. The Examiner has rejected Claim 17 "*for the same reasons set forth to rejecting claim 1, 6 and 9 above*". The Examiner then puts forth a contention that Reber discloses "*that the temporal specifier comprises a date, time, or date and time which is encoded into the electronic message by the sending system*".

In the section put forth for supporting the contention, the Applicant finds only that the system of Reber can read advertisements which contain departure or arrival dates - there is nothing by which this equates to the elements recited in Claim 17.

The "*date, time or date*" aspects of Reber are only marginal similarity that both mention date and time "read" in some manner. Examiner has provided no support for the use of date and time being equivalent to the "*decoding a temporal specifier*", "*storing ...until the specified time coordinate arrives*", and "*sending...in accord with the temporal specifier retained in the electronic message*". Consequently, no support exists for the rejection.

For a reference to anticipate in terms of §102, every element of the claimed invention must be identically shown in a single reference. Diversitech Corp. v. Century

Appl. No.: 09/800,083
Amdt. Dated: September 16, 2005
Off. Act. Dated: May 16, 2005

Steps, Inc. 850 F.2d 675, 677, 7 USPQ2d 1315, 1317 (Fed.Cir. 1988). These elements must be arranged as in the claim under review, Linderman Maschinenfabrik v. American Hoist & Derrick Co. 730 F.2d 1452, 1458, 221 USPQ 481,485 (Fed.Cir. 1984).

Therefore, Applicant respectfully requests that the rejection of Claim 17 and the claim which depend therefrom be withdrawn.

Claims 2-10, 12-16, and 18-20. These dependent claims are based on claims which have been shown to not be anticipated by the Reber reference, wherein the claims should be considered *a fortiori* allowable.

However, a number of these claims contain elements which provide separate grounds for patentability with respect to Reber or the other reference put forth.

Claims 4-5. Examiner attempts to combine an ISP aspect from Mayle to overcome that aspect recited in Claims 4-5, however, there are a number of shortcomings with the rejection.

First, the combination does not result in the claimed invention as neither of the references, or the combination, provides for the temporal displacement. As already described there is no teaching in Reber which comports to the use of the temporal specifier, this problem is not cured by the inclusion of Mayle.

Second, the references are drawn to different purposes and different operating principles, and those purposes and principles are different still from that of the instant application.

Specifically, Mayle is directed at the goal of sending an electronic postcard and describes the purpose at the end of the background (see col. 2, lines 28-33): "None of the current mechanisms allow the user to transfer a digital photograph to a server, process the image data into a display and send a notification to one or more specific individuals to view the display". The operating principles of Mayle rely on image conversion (col. 2, lines 55-61), an analog of a postcard (col. 2, lines 39-41), and

Appl. No.: 09/800,083
Amdt. Dated: September 16, 2005
Off. Act. Dated: May 16, 2005

viewing the postcard with a browser (col. 2, lines 64-66).

In contrast the system of Reber has the goal of navigating a network in response to reading of an optical code (elements 14, 32 in Fig. 1; col. 2, lines 19-23). The operating principles use a bar code reader, or similar optical reader (col. 2, lines 58-62), to discern an address and task for navigating the Internet (Field of Invention; col. 1, line 65 through col. 2 line 4).

So although the combination does not arrive at what is claimed by the Applicant, the references also do not provide similar objects and operating principles and cannot be combined.

In addition, the only suggestion, motivation or incentive for making such a combination is that which is taught by the Applicant.

Accordingly, Claims 4-5 provide separate grounds for patentability and there is no support for these aspects being obvious in view of the cited references.

Claim 9. Dependent Claim 9 describes a mechanism by which the temporal displaced message is directed to be automatically sent additional time in response to escalation commands.

There is no teachings in the relied upon Reber reference for this. Nothing specific is put forth within the relied upon large sections of the Reber reference, and Applicant is unable to find anything relevant whatsoever in these sections.

Claims 12-13. Dependent claims 12-13 are rejected based on Reber. Examiner puts forth that *"Reber discloses that the retention system comprises a mail server provided by the internet service provider (ISP) of the sender and the internet service provider (ISP) of the recipient at the destination address."*

It is interesting to note how this appears to contradict the statement with regard to Claims 4-5, wherein the Examiner states: *"Reber et al. does not disclose that the internet service provider (ISP) for the sending system and the internet service provider*

(ISP) of the recipient at the destination address". Although, neither of the statements is particularly understandable, and certainly provides no insight into the inventive aspects of the claims.

Claims 14, 15. Dependent Claims 14-15 describe particular instances of the temporal specifier being a particular day (Claim 14), or particular day and time (Claim 15).

In support of the rejection the Funk reference is brought in as it has a mention of the "day and time". Examiner references column 6, lines 38-52; column 7, lines 43-51; column 11, lines 29-35; and column 11, line 64 through column 12 line 11.

However, these references describe nothing of a temporal specifier to direct delivery as recited in applicants claims. Specifically, at col. 6 lines 38-52 the only reference to time is as follows: "*As described in more detail below, at predetermined intervals, such as one per day, processing system 210 generated a temporary list or file of all information to be delivered via emails to end users.*" Clearly this has no relationship to that described in Claims 14, 15 as depending on what is described about the temporal specifier of Claim 11. The remaining references are similarly non-supportive of the rejection.

It should be appreciated that the system of Funk is directed at the sending of bulk (high volume) emails from a host site, and not from one individual to another. In column 3, lines 5-10 Funk describes how the current lookup approaches to the DNS slows down bulk email delivery for "*sites that transmit thousands, or even hundreds of thousands of e-mail messages a day...*".

Accordingly, there is no support for the rejection of Claims 14-15.

Claim 16. Dependent Claim 16 describes a mechanism by which the email message being held pending its temporal specifier can be edited and deleted.

Appl. No.: 09/800,083
Amdt. Dated: September 16, 2005
Off. Act. Dated: May 16, 2005

In support of the rejection Examiner asserts that Reber provides this mechanism, but gives only a huge section of text (col. 4, line 17 through col. 6 line 44). There is nothing in the text that supports the assertion. It will be recognized that as mentioned previously, Reber does not provide for storing of the messages "until the specified time coordinate arrives" as recited in base claim 11, wherein any editing that is not related to this particular email being held prior to the specified time coordinate can not be equated to the claimed invention.

Accordingly, there is no support for the rejection of Claim 16 as it provides separate patentable distinction over the cited reference.

Claim 19, 20. Dependent Claims 19-20 recite additional aspects of the temporal specifier, in particular its being "*removed*" prior to sending to destination, and the encoding of the temporal specifier in the "*addressing or subject fields*" of the email.

Examiner has rejected these claims but provides NO support. Neither is Applicant able to find anything in any of the relied-upon reference which equates to this aspect of the invention.

Therefore, it has been shown that the relied upon references do not support the claims rejections, wherein Applicant respectfully requests that the rejection of Claims 1-20 be withdrawn.

3. Amendment of Claims 4-5, 11-13 and 17.

Claims 4-5 and 12-13. These dependent claims were amended to correct a supposed antecedent basis issue relating to "the internet service provider", changing it to "an internet service provider".

Claim 11. Independent Claim 11 was amended to correct the preamble to be in line with that of Claim 1 (it was already interpreted in that manner anyway), and to include the specifier "from the network" to provide better antecedent basis.

Appl. No.: 09/800,083
Amdt. Dated: September 16, 2005
Off. Act. Dated: May 16, 2005

Claim 17. Independent Claim 17 was amended to remove some redundant garbage on the line reciting the programming and to properly recite “programming executable on said computer system”, which is already discussed in other claims such as Claims 2-3. Applicant apologizes for syntax *faux-pas*’.

Applicant also added the term “time coordinate” to provide clearer antecedent basis as two different terms were used. In addition, the phrase “*specified temporal specifier*” was rewritten to read “*temporal specifier retained within said electronic message*” which is more clear, yet maintains the same meaning.

4. Amendments Made Without Prejudice or Estoppel.

Notwithstanding the amendments made and accompanying traversing remarks provided above, Applicant has made these amendments to correct antecedent issues brought up by the Examiner and found separately. These amendments were not made to overcome any grounds of rejection and have been made without any prejudice, waiver, or estoppel, and without forfeiture or dedication to the public, with respect to the original subject matter of the claims as originally filed or in their form immediately preceding these amendments. Applicant reserves the right to pursue the original scope of these claims in the future, such as through continuation practice for example.

5. Extension of Time Petition.

The Applicant has enclosed a petition for a **one-month** extension of time to respond to the Office Action and has enclosed the appropriate petition fee.

6. Conclusion.

Each of these presently pending claims in this application are believed to be in immediate condition for allowance.

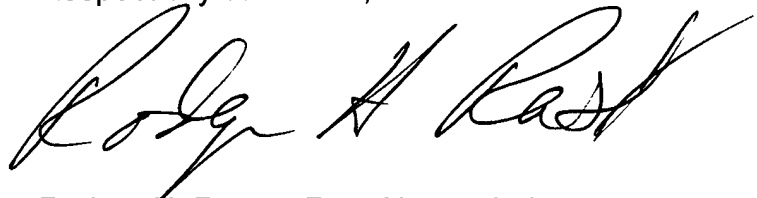
The Applicant respectfully requests a response/interview (email/phone) with the Examiner to clarify any issues that arise upon examination on the merits of the present

Appl. No.: 09/800,083
Amdt. Dated: September 16, 2005
Off. Act. Dated: May 16, 2005

application, if an allowance of all claims does not appear forthcoming.

Date: Sept. 16, 2005

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Rodger H. Rast". The signature is fluid and cursive, with a large initial "R" and a stylized "H".

Rodger H. Rast Reg. No. 45,853
c/o Rastar Corporation
11230 Gold Express Drive
Suite 310 MS 337
Gold River, CA 95670

Rodger@rastar.us
(916) 631-9043